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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,563	09/25/2003	Tseng-Lu Chien	CHIE3038/BEU	4014

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EXAMINER

HAN, JASON

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/669,563	CHIEN, TSENG-LU	
	Examiner	Art Unit	
	Jason M. Han	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed August 9, 2005 have been fully considered but they are not persuasive.
2. In response to Applicant's argument, "Nowhere does the Chien patent suggest 'means for attaching the super thin lighting element to the transparent member' (rather than the main object)", the Examiner based the rejection on a broad interpretation [MPEP 2111] whereby the prior art of record remains commensurate to the scope of the claim as stated by Applicant.
3. To elucidate, Chien discloses, "the strap 4 includes a recess 14 shaped to accommodate electro-luminescent strip 15, and further includes a protective member 16 which covers the electro-luminescent strip and which can provide sealing against moisture and, if desired, harmful ultraviolet radiation [Column 3, Lines 60-64...please further note Column 4, Lines 1-7]." The very nature that the recess accommodates the super thin lighting element 15 and the protective member/transparent optical member 16 covers said lighting element by attaching to the strap 4 is itself a means for attachment.
4. At present, "means" is broadly interpreted to incorporate any manner by which the lighting element is attached to the transparent member, and thus, the claims remain unpatentable over the prior art of record. The Applicant is encouraged to further define the means as to how the super thin lighting element is specifically attached to the transparent member.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 7-14, and 16-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Chien (U.S. Patent 5746501).
6. With regards to Claim 1, Chien discloses an optical effects device including a transparent optical member [Figures 2A-2C: (16, 18, 19)] having a shape which determines optical properties of the transparent member; a super thin lighting element [Figures 2A-2C: (15)]; means [Column 3, Line 48 – Column 4, Line 7] for attaching the super thin lighting element to the transparent member; and means [Column 3, Line 48 – Column 4, Line 7] for fixing the transparent optical member relative to a main object.
7. With regards to Claim 2, Chien discloses the super thin lighting element being an electroluminescent lighting element [Column 3, Line 61] that includes electrical circuitry [Figures 4-5; Column 4, Lines 24-36].
8. With regards to Claim 3, Chien discloses the lighting element being a photoluminescent element [Column 3, Lines 23-30].
9. With regards to Claim 4, Chien discloses the optical effects device including a stuffing material [Figures 2A-2C: (18, 19)] that encloses and protects the lighting element, whereby the stuffing material is the material of foam/the optical member [Column 4, Lines 13-23].

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10. With regards to Claim 5, Chien discloses the lighting element being an electroluminescent source with access to a battery and switch, whereby control circuitry for the lighting element is placed inside the stuffing [Column 4, Line 49 – Column 5, Line 21].

11. With regards to Claim 7, Chien discloses optical properties being a function of different thicknesses of the transparent member [Column 4, Lines 1-13].

12. With regards to Claim 8, Chien discloses, "Super thin lighting elements such as electro-luminescent strips or panels offer a number of advantages over conventional lighting elements such as incandescent light bulbs and light emitting diodes. These advantages include flexibility, which allows the lighting elements to follow curves on the object to which they are attached, the ability to be printed or silk-screened with logos, marks, figures, and characters, or to be stenciled or masked, a wide variety of color choices, including green, blue, pink, yellow, and white, and low assembly and design costs [Column 1, Lines 18-28; underline added for emphasis]."

13. With regards to Claim 9, Chien discloses the lighting element including both electroluminescent and photoluminescent elements [Column 3, Lines 26-29].

14. With regards to Claim 10, Chien discloses the fixing means including means [Column 3, Line 48 – Column 4, Line 7] for fixing the transparent optical device securely to a surface of the main object.

15. With regards to Claim 11, Chien discloses the lighting element being affixed to an inside surface of the transparent optical member [Figures 2A-2C], whereby the transparent optical member [Figures 2A-2C: (16, 18, 19)] is in the form of a sheet.

16. With regards to Claim 12, Chien discloses, "combination EL and PL strips formed by mixing together EL and PL particles within a single carrier or by joining together discrete EL and PL elements [Column 3, Lines 26-30]." It is also inherent that the particles would be of different diameter particles.

17. With regards to Claim 13, Chien discloses the fixing means being stitching, ultrasonic welding, VelcroTM, press-fitting, mechanical fasteners, adhesives, or solvents [Column 4, Lines 1-23].

18. With regards to Claim 14, Chien discloses additional lighting elements facing in different directions [Figures 6-8].

19. With regards to Claim 16, Chien discloses the main object being a clock [Figures 1-8].

20. With regards to Claim 17, Chien discloses the lighting element serving as a backlight [Figures 1-8].

21. With regards to Claim 18, Chien discloses the lighting element being an electroluminescent source and the optical effects device including a self-contained housing for a battery, switch, and circuitry [Figures 4-5].

22. With regards to Claim 19, Chien discloses the circuitry being enclosed [Column 4, Lines 24-36], whereby access is available only to the switch and battery [Column 5, Lines 11-20; see also Figures 4-5].

23. With regards to Claim 20, Chien discloses the optical effects device including a plurality of main objects [Figures 1-8].

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24. With regards to Claim 21, Chien discloses the main object attached to a plurality of optical effects devices, wherein the optical effects devices share a single control circuit positioned on the main object [Figure 8].

25. With regards to Claim 22, Chien discloses the lighting element including an electroluminescent element, and a power pack [Figures 5 & 8: (40)] positioned on the main object outside the optical effects device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chien (U.S. Patent 5746501) as applied to Claim 1 above.

27. With regards to Claim 6, Chien discloses the claimed invention as cited above, but does not specifically teach the transparent optical member being made of a material selected from the group consisting of polyvinyl chloride, ABS, polyethylene, polypropylene, silicone, rubber, epoxy, and PC, wherein the member includes at least one transparent area (inherent: transparent optical member).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the device out of one of the abovementioned materials, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of

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obvious design choice. *In re Leshin*, 125 USPQ 416. In this case, the above materials are suitable for transmitting light and flexible/resilient properties.

28. With regards to Claim 15, Chien discloses the claimed invention as cited above except for the main object being situated within the transparent optical member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the optical member around the main object, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. In this case, rearranging the main object within the optical member may further provide protection, as well as an aesthetic appeal.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (9/20/2005)


Stephen Husar
Primary Examiner